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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,669	12/21/2000	Brian M. Siegel	50N3787	5754

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EXAMINER

RHODE JR, ROBERT E

ART UNIT PAPER NUMBER

3625

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/745,669	Applicant(s) SIEGEL ET AL.	
	Examiner Rob Rhode	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 5 - 7, 28 and 31 - 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5 - 7, 28 and 31 - 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

Applicant amendment of 4-705 amended claims 1, 5, 7 and 28 as well as canceled claims 2 – 4, 8 – 27, 29 – 30 and 33 – 41.

Currently, claims 1, 5 – 7, 28 and 31 – 32 are pending.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For example, the specification does not disclose/describe or provide a specific definition for one of ordinary skill to determine the meaning of the phrase “in mechanical communication”, which precludes determining the metes and bounds of the invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 1, the phrase "in mechanical communication " is a relative phrase, which renders the claims indefinite. The phrase "in mechanical communication" is not defined by the claim(s), the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For examination purposes, the phrase "in mechanical communication" will be treated as an enhanced device such as key chain or a smart card, in which the scanner is incorporated/integrated.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 5 – 7, 28 and 31 - 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena (US 6,448,979 B1) in view of Kocher (US 6,652,455 B1).**

Regarding claim 1, 7 and 28. (Currently Amended), Schena teaches a method for retrieving information related to a consumer product comprising the steps of: integrating a bar code scanner and a removable memory into a consumer good, wherein said consumer good comprises a non-electronic device; scanning a bar code of a selected consumer product using the integrated scanner and storing the scanned bar code; transferring the scanned bar code to a computer network; and accessing a web site on the computer network based on the scanned bar code, wherein said web site includes information related to the selected consumer product (see at least Col 3, lines 42 – 63, Col 4, lines 32 – 37, Col 5, lines 34 – 39 and Col 6, lines 27 – 36).

While Schena does disclose storing of the scanned bar code/data in an enhanced device such as key chain or a smart card, in which the scanner is

incorporated/integrated, the reference does not specifically disclose and teach a removable memory.

On the other hand and in the same area of storing data in scanning device, teaches storing the data in a removable memory (Col 5, lines 27 -30).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the apparatus and method of Schena with the apparatus and method of Kocher to meet the claim limitations of claim 28. Schena discloses a method and apparatus for retrieving information related to a consumer product comprising the steps of: integrating a bar code scanner and a removable memory into a consumer good, wherein said consumer good comprises a non-electronic device; scanning a bar code of a selected consumer product using the integrated scanner and storing the scanned bar code; transferring the scanned bar code to a computer network; and accessing a web site on the computer network based on the scanned bar code, wherein said web site includes information related to the selected consumer product (see at least Col 3, lines 42 – 63, Col 4, lines 32 – 37, Col 5, lines 34 – 39 and Col 6, lines 27 – 36). In turn, Kocher discloses a method and apparatus for storing the data in a removable memory of a scanner (Col 5, lines 27 -30). Therefore, one of ordinary skill in the art would have been motivated to extend the method and apparatus of Schena with a method and apparatus for apparatus for storing the data in a removable memory of a scanner.

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Regarding claim 5 (Currently Amended), Schena teaches an apparatus, wherein said non- electronic device comprises one of the following: an article of clothing, a pen and a pocketbook (Col 3, line 53).

Regarding claim 6 (Original), Kocher teaches an apparatus, wherein said removable memory medium comprises one of the following: a magnetic disc, flash memory, a smart card, a memory stick, a diskette, a CD-ROM, a disk drive, a random access memory chip, and an optical storage device (Col 5, lines 27 – 30). Please note that Kocher does not specifically disclose a smart card. However, Schena does disclose a smart card. In that regard, it would have been obvious to one of ordinary skill in the art at the time of the invention to have extended the removable memory disclosed by Kocher, with removable memory such as a smart card.

Regarding claim 31 (Original), Schena teaches a method, further comprising converting a scanned bar code to a uniform resource locator of a web site (Col 4, lines 32 – 37).

Regarding claim 32 (Original), the recitation “further comprising converting a scanned bar code and a global position to a uniform resource locator (URL) of a web site), such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other “converting” already disclosed by Schena.

***Response to Arguments***

Applicant's arguments with respect to claims 1, 5 – 7, 28 and 31 - 32 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

***Alexandria, Va. 22313-1450***

or faxed to:

**(703) 872-9306**

[Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached at

**571.272.3600**

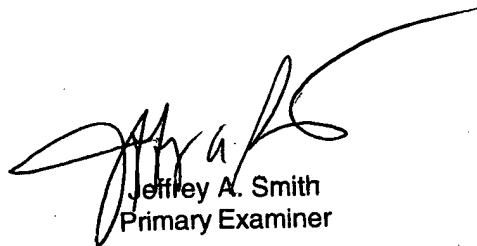
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.



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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). RER



Jeffrey A. Smith  
Primary Examiner